

Atty. Dkt. No. 039153-0694 (H1725)

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

The Title and Abstract have been amended for clarity. No new matter is added.

No claims are requested to be cancelled.

Claim 3 is currently being amended. No new matter is added.

No claims are being added.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-8 are now pending in this application.

On page 2 of the Office Action, the Examiner has withdrawn claims 9-16 and 21-24. Accordingly, claims 1-8 remain pending in the application.

On page 3 of the Office Action, claim 3 is rejected under 35 U.S.C. § 112, second paragraph for indefiniteness. Applicant has amended claim 3 in accordance with the Examiner's suggestion. Accordingly, withdrawal of the rejection of claim 3 is respectfully requested.

On pages 1 and 2 of the Office Action, claims 1-2 and 4-5 are rejected under 35 U.S.C. § 103(e) as being anticipated by U.S. Patent No. 6,770,530 (Efferenn). The Examiner states:

Regarding claim 1, Efferenn discloses a method of manufacturing an integrated circuit having trench isolation regions in a substrate, the method comprising (Figs. 1-8):

Forming a mask layer above the substrate;

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Selectively etching the mask layer to form apertures associated with locations of the trench isolation regions;

Forming trenches in the substrate at the locations (Figs. 6-8);

Forming first type liners (15) on first side walls of the trenches associated with first type regions of the substrate (P-FET region Figs. 6-8); and

Forming second type liners (15 and 19) on second side walls of the trenches associated with second type regions (N-FET region Fig. 8)..

Applicant respectfully traverses the rejection.

On page 5 of the Office Action, claims 6-8 are rejected under 35 U.S.C. § 103 as being unpatentable over Efferenn in view of U.S. Patent No. 6,737,706 (Lee). The Examiner states:

Regarding claims 6-7, Efferenn discloses the method of claim 1 as mentioned above, however, Efferenn does not explicitly disclose wherein the substrate is on an SOI substrate as in regards to claim 6 or that the substrate trenches reach a buried insulative layer of the substrate as in regards to claim 7. Lee discloses that it is known in the art to form trench isolation features (41) on SOI substrates (30) wherein the trenches reach the buried insulative layer (15) (Fig. 1 and Col. 1). It would have been obvious to one of ordinary skill in the art to implement Efferenn's method with a SOI substrate as taught by Lee because Lee explicitly disclosures in the background section that such teachings are conventional.

Applicant respectfully traverse the rejection.

Applicant respectfully submits that Efferenn is not available as a prior art reference against the claims of the present application. A Declaration by the inventor pursuant to 37 C.F.R. 1.131 has been provided herewith. The Declaration provides evidence that the subject matter recited in claims 1-8 was invented prior to the filing date of Efferenn. According to the cover page of Efferenn, Efferenn was filed on March 10, 2003. The Declaration establishes that the subject matter recited in claims 1-8 was conceived at least by November 11, 2002, when a

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patent harvesting session was performed at Advanced Micro Devices, Inc., the assignee of the present application.

Exhibit A attached to the Declaration includes an invention disclosure form that includes drawings and statements establishing the invention and the subject matter recited in claims 1-8 at least by November 22, 2002, which is before the March 10, 2003 filing date of Efferenn. Accordingly, the rejection of claims 1-8 should be withdrawn because Efferenn is not available as prior art under 35 U.S.C. §102(e) against such claims. Reconsideration and withdrawal of the rejection of claims 1-8 under 35 U.S.C. § 102(e) is therefore respectfully requested.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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